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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,600	03/10/2000	Kiyoshi Toyoda	P19203	5789

7055 7590 02/19/2004

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RESTON, VA 20191

EXAMINER
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BAUGH, APRIL L

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 02/19/2004

20

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/522,600

Applicant(s)

TOYODA, KIYOSHI

Examiner

April L Baugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 27-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 27-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 29, 2003 has been entered.

### ***Response to Amendment***

Applicant has amended independent claims 1, 27, 34, 36, and 39 therefore claims 1 and 27-40 are now pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 27, 34, 36, and 39 in view of Toyoda et al. have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant's arguments filed October 29, 2003 in view of Idehara and Reed et al. have been fully considered but they are not persuasive.

Applicant argues that Idehara does not teach the transmitter, in the first mode, directly transmits image data to the image receiving apparatus by use of the IP address in response to the IP address being obtained by the processor, and, in the second mode, indirectly transmits image data to the image receiving apparatus via a mail server in response to the IP address not being

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obtained by the processor. It is the examiner's position that Idehara teaches the above feature (column 9, lines 35-53 and Fig. 16). Idehara states "when the destination information is an email address, the converted document data is attached to an email and the email is sent to the specified email address. In the case where the judgement step reveals that the destination information is an IP address, the document is sent to the specified IP address based on the file transfer protocol". Here the IP address has been obtained thus the document data (image data) is sent by the IP address, on the other hand if there isn't an IP address but an email address the data is emailed via a mail server. Therefore it is the examiner's position that Idehara teaches directly transmitting image data to the image receiving apparatus by use of the IP address in response to the IP address being obtained by the processor, and, in the second mode, indirectly transmits image data to the image receiving apparatus via a mail server in response to the IP address not being obtained by the processor.

Applicant argues that Reed et al. does not teach an image receiving apparatus to which a changeable IP address is assigned by an external apparatus. It is the examiner's position that the above feature is taught in Reed et al. (column 3, lines 33-38 and Fig. 1). Reed et al. states "Whenever a new device connects to the network, it contacts the DHCP server that maintains a set of IP addresses. The DHCP server chooses one of the addresses and then allocates the address to the device". Here the device is the above apparatus which contacts the DHCP which is an external apparatus from the image receiving apparatus to be assigned an IP address. Therefore it is the examiner's position that Reed et al. teaches an image receiving apparatus to which a changeable IP address is assigned by an external apparatus.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1, 27-40 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,812,278 to Toyoda et al. in view of Idehara, and further in view of Reed et al.

Regarding claim 1, Toyoda et al. teaches an image transmitting apparatus for transmitting image data to an image receiving apparatus (column 1, lines 29-31 of Toyoda et al.), the image transmitting apparatus comprising: a memory that stores a table including an address of the image receiving apparatus (column 10, lines 64-65); wherein the memory stores the address in association with a destination mail address (column 1, lines 45-46 of Toyoda et al.); an inputter for inputting the destination mail address (column 10, lines 66-67 of Toyoda et al.); and a searcher for searching the address corresponding to the destination mail address input by the inputter (column 7, lines 39-42 and column 22, lines 1-16 of Toyoda et al.).

Toyoda et al. does not teach direct and indirect transmission of an image. Idehara teaches wherein the transmitter, in the first mode, directly transmits image data to the image receiving apparatus by use of the IP address in response to the IP address being obtained by the processor, and, in the second mode, indirectly transmits image data to the image receiving apparatus via a mail server in response to the IP address not being obtained by the processor (column 9, lines 35-53 of Idehara). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. by having

indirect and direct transmission of an image because with an option of direct transmission delays such with email delivery can be avoided.

Toyoda et al. in view of Idehara does not teach of a changeable IP address nor that the fixed address comprises a MAC (Media Access Control) address. Reed et al. teaches an image receiving apparatus to which a changeable IP address is assigned by an external apparatus according to first and second modes (column 3, lines 33-38 of Reed et al.) and fixed address comprises a MAC (Media Access Control) address (column 1, lines 44 and 46-47); a memory that stores a table including a fixed address of the image receiving apparatus; and a searcher for searching the fixed address corresponding to the destination mail address input by the inputter (column 3, lines 1-14); a processor configured to obtain the current IP address of the image receiving apparatus by use of the fixed address stored in the memory; wherein the processor obtains the IP address of the image receiving apparatus by use of the fixed address searched by the searcher (column 2, lines 49-57). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. in view of Idehara by having a changeable IP address assigned because this is an automatic way of assigning an IP address which is needed to transmit an image from one apparatus to another and by and the fixed address comprises a MAC (Media Access Control) address because a MAC address is a type of fixed physical address which the memory stores.

Referring to claim 27, Toyoda et al. teaches an image transmitting apparatus for transmitting image data to an image receiving apparatus (column 1, lines 29-31 of Toyoda et al.), the image transmitting apparatus comprising: a memory that stores a table including a plurality of addresses each corresponding to one of a plurality of image receiving apparatus (column 10,

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lines 64-65), the address being association with destination data (column 1, lines 45-46 of Toyoda et al.); an inputter that inputs destination data (column 10, lines 66-67 of Toyoda et al.); a searcher that searches t addresses stored in said memory, and that obtains a address corresponding to the destination data input by said inputter (column 7, lines 39-42 and column 22, lines 1-16 of Toyoda et al.).

Toyoda et al. does not teach direct and indirect transmission of an image. Idehara teaches wherein the transmitter, in the first mode, directly transmits image data to the image receiving apparatus by use of the IP address in response to the IP address being obtained by said processor, and, in the second mode, indirectly transmits image data to the image receiving apparatus via a mail server in response to the IP address not being obtained by the processor (column 9, lines 35-53 of Idehara). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. by having indirect and direct transmission of an image because with an option of direct transmission delays such with email delivery can be avoided.

Toyoda et al. in view of Idehara does not teach of a changeable IP address nor that the fixed address comprises a MAC (Media Access Control) address. Reed et al. teaches an image receiving apparatus to which a changeable IP address is assigned by an external apparatus according to first and second modes (column 3, lines 33-38 of Reed et al.) and fixed address comprises a MAC (Media Access Control) address (column 1, lines 44 and 46-47); a memory that stores a table including a fixed address of the image receiving apparatus; and a searcher for searching the fixed address corresponding to the destination mail address input by the inputter (column 3, lines 1-14); a processor configured to obtain the current IP address of the image

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receiving apparatus to which the image data is transmitted , by use of the fixed address obtained by said searcher (column 2, lines 49-57). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. in view of Idehara by having a changeable IP address assigned because this is an automatic way of assigning an IP address which is needed to transmit an image from one apparatus to another and by and the fixed address comprises a MAC (Media Access Control) address because a MAC address is a type of fixed physical address which the memory stores.

Referring to claim 34, Toyoda et al. teaches an image transmitting apparatus for transmitting image data to an image receiving apparatus (column 1, lines 29-31 of Toyoda et al.), the image transmitting apparatus comprising: a memory that stores a table including a plurality of addresses each corresponding to one of a plurality of image receiving apparatus (column 10, lines 64-65).

Toyoda et al. does not teach direct and indirect transmission of an image. Idehara teaches the image transmitting apparatus transmitting the image data to an image receiving apparatus indirectly via a mail server (column 8, lines 45-60 of Idehara) and a transmitter that directly transmits the image data to the image receiving apparatus by use of the IP address obtained by said processor in response to the processor obtaining the IP address(column 8, lines 4-7 of Idehara). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. by having indirect and direct transmission of an image because with an option of direct transmission delays such with email delivery can be avoided.



Toyoda et al. in view of Idehara does not teach of a changeable IP address nor that the fixed address comprises a MAC (Media Access Control) address. Reed et al. teaches an image receiving apparatus to which a changeable IP address is assigned by an external apparatus according to first and second modes (column 3, lines 33-38 of Reed et al.) and fixed address comprises a MAC (Media Access Control) address (column 1, lines 44 and 46-47); a memory that stores a table including a fixed address of the image receiving apparatus (column 3, lines 1-14); a processor configured to obtain the current IP address of the image receiving apparatus to which the image data is transmitted, by use of the fixed address stored in said memory (column 2, lines 49-57). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. in view of Idehara by having a changeable IP address assigned because this is an automatic way of assigning an IP address which is needed to transmit an image from one apparatus to another and by and the fixed address comprises a MAC (Media Access Control) address because a MAC address is a type of fixed physical address which the memory stores.

Referring to claim 36, Toyoda et al. teaches a method for transmitting image data to an image receiving apparatus (column 1, lines 29-31 of Toyoda et al.), the method comprising: storing a plurality of addresses each corresponding to one of a plurality of image receiving apparatuses into a memory (column 10, lines 64-65 of Toyoda et al.), the addresses being associated with a destination data (column 1, lines 45-46 of Toyoda et al.); inputting a destination address to which the image data is transmitted (column 10, lines 66-67 of Toyoda et al.); searching the addresses stored in the memory, corresponding to the input destination address (column 7, lines 39-42 and column 22, lines 1-16 of Toyoda et al.)

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Toyoda et al. does not teach direct and indirect transmission of an image. Idehara teaches utilizing an image transmitting apparatus which indirectly transmits the image data to an image receiving apparatus via a mail server (column 8, lines 45-60 of Idehara) and a transmitter that directly transmits the image data to the image receiving apparatus by use of the IP address obtained by said processor in response to an IP address being obtained (column 8, lines 4-7 of Idehara). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. by having indirect and direct transmission of an image because with an option of direct transmission delays such with email delivery can be avoided.

Toyoda et al. in view of Idehara does not teach of a changeable IP address nor that the fixed address comprises a MAC (Media Access Control) address. Reed et al. teaches an image receiving apparatus to which a changeable IP address is assigned by an external apparatus according to first and second modes (column 3, lines 33-38 of Reed et al.) and fixed address comprises a MAC (Media Access Control) address (column 1, lines 44 and 46-47); a memory that stores a table including a fixed address of the image receiving apparatus; and a searcher for searching the fixed address corresponding to the destination mail address input by the inputter (column 3, lines 1-14); obtaining a current IP address of an image receiving apparatus to which the image data is transmitted, by use of the fixed address (column 2, lines 49-57). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. in view of Idehara by having a changeable IP address assigned because this is an automatic way of assigning an IP address which is needed to transmit an image from one apparatus to another and by and the fixed address comprises a MAC

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(Media Access Control) address because a MAC address is a type of fixed physical address which the memory stores.

Regarding claim 39, Toyoda et al. teaches a method for transmitting image data to an image receiving apparatus (column 1, lines 29-31), the method comprising: storing a plurality of addresses each corresponding to one of a plurality of image receiving apparatuses into a memory (column 10, lines 64-65).

Toyoda et al. does not teach direct and indirect transmission of an image. Idehara teaches utilizing an image transmitting apparatus which indirectly transmits the image data to an image receiving apparatus via a mail server (column 8, lines 45-60 of Idehara) and a transmitter that directly transmits the image data to the image receiving apparatus by use of the IP address obtained by said processor in response to obtaining of an IP address (column 8, lines 4-7 of Idehara). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. by having indirect and direct transmission of an image because with an option of direct transmission delays such with email delivery can be avoided.

Toyoda et al. in view of Idehara does not teach of a changeable IP address nor that the fixed address comprises a MAC (Media Access Control) address. Reed et al. teaches an image receiving apparatus to which a changeable IP address is assigned by an external apparatus according to first and second modes (column 3, lines 33-38 of Reed et al.) and fixed address comprises a MAC (Media Access Control) address (column 1, lines 44 and 46-47); a memory that stores a table including a fixed address of the image receiving apparatus (column 3, lines 1-14); obtaining a current IP address of an image receiving apparatus to which the image data is

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transmitted, by use of the fixed addresses stored in memory (column 2, lines 49-57). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. in view of Idehara by having a changeable IP address assigned because this is an automatic way of assigning an IP address which is needed to transmit an image from one apparatus to another and by and the fixed address comprises a MAC (Media Access Control) address because a MAC address is a type of fixed physical address which the memory stores.

Regarding claim 30, Toyoda et al. in view of Idehara teaches the image transmitting apparatus according to claim 27 (column 1, lines 29-31 of Toyoda et al. and column 9, lines 35-53 of Idehara).

Toyoda et al. does not teach the changeable IP address is assigned by a DHCP server. Reed et al. teaches wherein the changeable IP address is assigned by a DHCP server (column 3, lines 33-38 of Reed et al.). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. in view of Idehara by having the changeable IP address be assigned by a DHCP server because the DHCP server automatically assigns an IP address which is needed to transmit an image from one apparatus to another.

Referring to claims 31, 35, 37, and 40, Toyoda et al. in view of Idehara teaches the image transmitting apparatus according to claim 27, 34, 36, and 39 (column 1, lines 29-31 of Toyoda et al. and column 9, lines 35-53 of Idehara).

Toyoda et al. in view of Idehara does not teach processor performs an RARP processing sequence to obtain the current IP address. Reed et al. teaches wherein said processor performs an

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RARP processing sequence to obtain the current IP address of an image receiving apparatus to which the image data is transmitted (column 2, lines 49-57 of Reed et al.). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. in view of Idehara by the processor performing an RARP processing sequence to obtain the current IP address of an image receiving apparatus because the RARP protocol is able to find the IP address based off of the physical (fixed) address that is provided.

Regarding claim 32 and 38, Toyoda et al. teaches the image transmitting apparatus according to claim 27 and 36 (column 1, lines 29-31 of Toyoda et al.).

Toyoda et al. does not teach detecting a mark and based on that performing either direct or indirect transmission of the image. Idehara teaches further comprising a detector that detects whether or not a specific mark is added to the input destination data; wherein said transmitter directly transmits image data to an image receiving apparatus by use of the IP address when the specific mark is not added to the destination data, and wherein said transmitter indirectly transmits image data to an image receiving apparatus by use of the IP address when the specific mark is added to the destination data (column 9, lines 35-53 of Idehara). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. by detecting a mark and based on that performing either direct or indirect transmission of the image because the detection of the mark allows the system to know whether an email address or and IP address has been provided and thus the transmission method is determined and with an option of direct transmission delays such with email delivery can be avoided.

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Regarding claim 33, Toyoda et al. teaches the image transmitting apparatus according to claim 32 (column 1, lines 29-31 of Toyoda et al.)

Toyoda et al. does not teach the specific mark comprises a @ mark. Idehara teaches wherein the specific mark comprises a @ mark (column 8, lines 14-16 of Idehara). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the image communication method of Toyoda et al. by detecting a @ mark and based on that performing either direct or indirect transmission of the image because the detection of the @ mark allows the system to know whether an email address or and IP address has been provided and thus the transmission method is determined and with an option of direct transmission delays such with email delivery can be avoided.

Regarding claim 28, Toyoda et al. teaches the image transmitting apparatus according to claim 27, wherein the transmitter directly transmits the image data to the image receiving apparatus when the image transmitting apparatus and the image receiving apparatus are connected without requiring access to the Internet (column 10, lines 45-48 and Fig. 3 of Toyoda et al.).

Referring to claim 29, Toyoda et al. teaches the image transmitting apparatus according to claim 27, wherein the image receiving apparatus comprises a personal computer connected to a network to which the image transmitting apparatus is connected (column 10, lines 45-48 and Fig. 3 of Toyoda et al.).


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April L Baugh whose telephone number is 703-305-5317. The examiner can normally be reached on Monday-Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal D Dharia can be reached on 703-305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

ALB

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER